REMARKS

Claims 50-65 presently stand rejected. Claims 38-49 were previously withdrawn in response to a restriction requirement mailed September 5, 2008. New claim 66 is presented herein. No claims have been amended or canceled. Thus, with the filing of this paper, claims 38-66 are pending. Reconsideration of the pending claims and entry of new claim 66 is respectfully requested.

Claim Rejections – 35 U.S.C. § 103

Claims 50-65 stand rejected under 35 U.S.C. § 103(a) over US Patent No. 5,754,233 to Takashima in view of U.S. Patent No. 5,812,699 to Zhu et al. ("Zhu"). Without conceding that either Takashima or Zhu are eligible references, Applicants respectfully traverse the rejections.

To establish a *prima facie* case of obviousness, the Examiner must show that the cited references teach each and every element of the claimed invention. (MPEP§2143) citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)). A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was independently known in the prior art. *KSR Int'l C. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007). If a combination or modification to a reference is used, an Examiner must show that there is some expectation of success that the combination or modification proffered would predictably result in the claimed invention. Obviousness is a question of law based on underlying factual *Graham* factors of determining the scope and content of the prior art, ascertaining the differences between the claimed invention and the prior art, and resolving the level of ordinary skill in the pertinent art.

Once the Graham factual inquiries are resolved, the Examiner must explain why the difference(s) between the cited references and the claimed invention would have been obvious to one of ordinary skill in the art. The rationale must be a permissible rationale. The USPTO promulgated Examination Guidelines for Determining Obviousness in View of KSR in the Federal Register, Vol. 72, No. 195 (October 10,

2007). These KSR guidelines enumerate permissible rationale and the findings of fact that must be made under the particular rationale. One such rationale is termed "Combining Prior Art Elements." This appears to be the basis for the Examiner's rejection of claims 50-65.

According to the Examination Guidelines for Determining Obviousness Under 35 USC 103 in View of KSR, to use the "Combining Prior Art Elements" rationale as basis for rejecting claims, an Examiner must articulate four things: (1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference; (2) a finding that one of ordinary skill could have combined the elements as claimed by known methods, and that in combination, each element merely would have performed the same function as it did separately; (3) a finding that one of ordinary skill would have recognized that the results of the combination were predictable; and (4) any additional findings based on the Graham factual inquiries to explain the conclusion of obviousness. If any of these findings cannot be made, then this rationale cannot be used to support a conclusion of obviousness. The Court in KSR noted that combining known prior art elements is not sufficient to render the claimed invention obvious if the results would not have been predictable. When the prior art teaches away from combining certain known elements, discovery of successful means of combining them is more likely to be nonobvious.

Applicant respectfully submits that in this instance this rationale cannot be used. Claim 55 recites, in pertinent part, "a compressor including the processor and the codec, the compressor further including a first data storage queue and a second data storage queue coupled to provide the processor separate from uncompressed image data stored in the first data storage queue, a respective current byte count of a current frame of the uncompressed image data stored in the first data storage queue and separate from compressed image data stored in the second data storage queue, a current byte count of the compressed image data stored in the second data storage queue, to allow the processor to facilitate an adjusting of a target frame rate."

In the Office Action, the Examiner cites Takashima for teaching each and every recitation of claim 55 except for disclosing "a respective current byte count of a current frame of the uncompressed image data," as claimed (Office Action, page 3). Thus, the

Examiner cites Zhu for curing the deficiencies of Takashima, stating it would have been obvious for one of ordinary skill in the art at the time of the invention to "modify the teachings of Zhu into the system of Takashima to provide an improved scheme for selecting frames for video compression." (Office Action, page 4). Applicants respectfully disagree.

Applicants submit that the Examiner has failed to show how one of ordinary skill could have combined the elements in Takashima and Zhu as claimed by known methods, and that in combination, each element merely would have performed the same function it did separately. At the very least, the function of timing control circuit 105, which the Examiner has characterized as Applicants claimed processor, would substantially differ from its function if it were to process and receive a "respective current byte count of a current frame of uncompressed data," in accordance with the teachings of Zhu. For example, timing control circuit 105 is driven by the inputs from scene detection element 101 and counter 104. Counter 104 does not count a byte count of uncompressed data, but detects "horizontal synchronization signals and vertical synchronization signals in the input video signal and counts the clocks in a macro-block, the number of macroblocks in the picture and the number of pictures in a group of pictures ("GOP") in a timed relation to these synchronization signals." (Takashima, col. 6, lines 62- col. 7, line 4). This information is used in conjunction with the input from scene detection element 101 to generate a variety of timing signals. The timing control circuit 105 sets the positions of I-, P- and B-pictures and the GOP points based on the detections of counter 104 and on the results of detection by the scene change detection circuit 101 (Takashima, Col. 7, lines 9-13).

Zhu teaches a video codec driver pre-processor 402 that is responsible for selecting frames from the video stream for compression. Applicants assume for the sake of argument that that pre-processor 402 receives the alleged "respective current byte count of a current frame of the uncompressed image data." According to column 9 of Zhu, pre-processor 402 determines whether compression is permitted of the current frame. In one aspect, video compression processing is not allowed to be ahead of the target frame rate, thus compression will not be permitted if compressing the current frame would have such a result. Whether or not the current frame is selected for

compression, a current level in a buffer is then decremented by the specified transmission rate. Pre-processor 402 may then deny permission for compressing the current frame.

Applicants respectfully submit that if timing control circuit 105 of Takashima were to receive "a respective current byte count of a current frame of the uncompressed image data stored in the first data storage queue," it is unclear how or for what purpose the timing control circuit 105 would process the uncompressed byte count. As noted above, timing circuit 105 sets the positions of I-, P- and B-pictures and the GOP points. If timing circuit 105 were to process the uncompressed byte count in a manner similar to the pre-processor 105 of Takashima, this would require timing control circuit 105 to grant permission for a single frame to be compressed based on a bit count. This would be a complete change in not only its present function but the functions and/or necessity of the elements coupled to it. Without further discussion, Applicants note that where the modification would require a substantial reconstruction and redesign of the elements shown in primary reference as well as a change in the basic principle under which the construction was designed to operate, then the teachings of the references are not sufficient to render the claims prima facie obvious. *In re Ratti*, 270 F.2d at 813, 123 USPQ at 352.

Accordingly, Applicants respectfully submit that because the Office has failed to show how one of ordinary skill could have combined the elements in Zhu and Takashima, and that in combination, each element would merely have performed the same function as it did separately, this rationale cannot be used to support a conclusion of obviousness. Applicants respectfully submit that claims 50 and 62 include one or more similar unobvious elements and are patentable over Takashima in view of Zhu. As for dependent claims 51 – 54, 56 – 61, and 63-65, these claims depend from independent claims 50, 55, or 62 incorporating their recitations. Thus, for at least the reason that claims 50, 55, or 62 are patentable over Takashima as described above, claims 51 – 54, 56 – 61, 63, and 64, are likewise patentable over Takashima.

Thus, for at least the foregoing reasons, Applicants request that the instant §103 rejections of claims 50 – 65 be withdrawn.

New Claim 66

It is respectfully submitted that new dependent claim 66 is allowable over the references. Support for new dependent claim 66 can be found in at least paragraph [0025] of the published application. New dependent claim 66 depends from claim 50 incorporating the recitations of its independent claim. Therefore, for at least similar reasons to those set forth above, Applicants submit that new dependent claim 66 is patentable over Takashima and Zhu under 35 U.S.C. § 103 (a).

CONCLUSION

In view of the foregoing remarks, Applicants believe the applicable rejections have been overcome and all claims remaining in the application are presently in condition for allowance. Accordingly, favorable consideration and a Notice of Allowance are earnestly solicited. The Examiner is invited to telephone the undersigned representative at (206) 407-1561 if the Examiner believes that an interview might be useful for any reason.

It is not believed that extensions of time are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a).

If any fees are due in connection with filing this paper, the Commissioner is authorized to charge the Deposit Account of Schwabe, Williamson and Wyatt, P.C., No. 50-0393.

Respectfully submitted,
SCHWABE, WILLIAMSON & WYATT, P.C.

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